

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM M. HEYN,  
ROBERT W. FRASER  
and DONALD J. ROTH

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Appeal No. 96-4165  
Application No. 08/333,292<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, PAK, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed November 1, 1994. According to appellants, this application is a division of Application 08/174,059, filed December 28, 1993, now U.S. Patent No. 5,360,588, issued November 1, 1994, which is a division of Application No. 07/764,546, filed September 24, 1991, now U.S. Patent No. 5,273,416, issued December 28, 1993.

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This is a decision on appeal from the examiner's final rejection of claim 13. Claims 19 and 20, which are all of remaining claims pending in this application, have been indicated as allowable by the examiner (answer, page 1).

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#### BACKGROUND

The appellants' invention relates to a method of molding a peripheral frame with a panel insert. An understanding of the invention can be derived from a reading of claim 13, which has been reproduced below.

13. A method of injection molding an article having a peripheral frame forming an opening and carrying an insert panel for closing said opening, said method comprising the steps of providing a split mold including an inner open quadrant, associating a strip of material with said mold in facing relation to said open quadrant, providing a punch opposing said strip material remote from said mold and in alignment with said mold, moving said punch towards said mold to first shear from said strip material a panel insert, then by continuing to move said punch towards said mold, clamping the panel insert against said mold with the panel insert and said punch forming parts of said mold and closing said open quadrant of said mold, and injecting a flowable material into said mold.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

|                          |           |          |
|--------------------------|-----------|----------|
| De Pass et al. (De Pass) | 3,463,845 | Aug.     |
| 26, 1969                 |           |          |
| Hatakeyama               | 4,459,092 | Jul. 10, |
| 1984                     |           |          |

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over De Pass in view of Hatakeyama.

#### OPINION

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We have carefully reviewed the respective positions presented by appellants and the examiner. In so doing, we find ourselves in agreement with appellants that the applied prior art fails to establish a prima facie case of obviousness regarding the claimed subject matter. Accordingly, we will not sustain the examiner's rejection for essentially those reasons advanced by appellants, and we add the following primarily for emphasis.

At the outset, we note that the examiner has the initial burden of presenting a prima facie case of obviousness based on the disclosure of the applied prior art. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

According to the examiner, De Pass discloses "...a process for forming an injection molded frame having a panel insert..." including the use of a punch for moving the insert (answer, page 3). Recognizing that De Pass does not teach the claimed step of "moving said punch towards said mold to first shear from said strip material a panel insert," the examiner relies on Hatakeyama for this step. According to the examiner, "[i]t would have been obvious for an artisan at the time of

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the invention, to modify the step of feeding the panel insert as taught by De Pass in view of Hatakeyama '092 to punch the insert from a continuous strip at the molding station rather than supplying discrete, pre-punched inserts to the mold assembly, since such would avoid the occurrence of non-uniform feed of the inserts to the mold cavity" (answer, page 4).

We cannot subscribe to the examiner's position regarding the combined references teachings as reproduced above. In our view, De Pass describes a molding process and device that explicitly relies on the use of sequentially fed blanks of material for forming composite container lids such as paper and plastic container lids (De Pass, columns 1-3) and does not describe any problems with the feeding of preformed blanks that would suggest the claimed process including the shearing step. Moreover, while Hatakeyama teaches use of a punch for punching out (shearing) an ornamental plate from a continuous strip of material for a plastic body, such as a cap for a bottle, the examiner has not identified any suggestion in the applied prior art for the use of such a technique for forming the composite container lids of De Pass especially in light of the sequential blank feed method taught by De Pass. In this

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regard, we note that the examiner has not shown where Hatakeyama teaches or would have suggested that the ornamental plates formed by its punch out (shearing) method can be used in a process as disclosed by De Pass wherein a sheared panel insert closes an opening in the article formed by an injection molding step.

The mere fact that the prior art may be modified to reflect features of the claimed invention does not make the modification obvious unless the desirability of such modification is suggested by the prior art. The claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. See In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Accordingly, on this record, the rejection fails for lack of a sufficient factual basis upon which to reach a conclusion of obviousness. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, the rejection of claim 13 under 35 U.S.C. § 103 as unpatentable over De Pass in view of Hatakeyama cannot be sustained.

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CONCLUSION

Based on the present record, we are unpersuaded that the examiner has met the initial burden of establishing a prima facie case of obviousness of the claimed process. The decision of the examiner is reversed.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 C.F.R.  
§ 1.136(a).

REVERSED

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|-----------------------------|---|-----------------|
| JOHN D. SMITH               | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| CHUNG K. PAK                | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
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|                             | ) |                 |
| PETER F. KRATZ              | ) |                 |
| Administrative Patent Judge | ) |                 |

PFK/dal



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